

## REMARKS

The present amendment is prepared in accordance with the new revised requirements of 37 C.F.R. § 1.121. A complete listing of all the claims in the application is shown above showing the status of each claim. For current amendments, inserted material is underlined and deleted material has a line therethrough.

The allowance of claims 26 – 30 is gratefully acknowledged. It is believed that the amendments above, in light of the remarks below make the remaining claims allowable.

### Drawings

The Examiner has objected to the drawings on the grounds that items "04," "05," "06," "31," "37," "38" and "85" are not disclosed in the specification. The items referred to above are labels that appear on the exterior of the lock and to identify by "function number" the functions that the lock can perform. A function (such as preventing the exterior handle from rotating) is provided by placing a blocking element in a location marked with the corresponding function number. The amendment to the specification above corresponds the specification to the drawings by introducing all of the function numbers into the specification that previously appeared only on the drawings.

It is believed that no new matter has been introduced as the specification previously described function numbers and the function numbers appeared on the original drawings.

**Rejections Under 35 U.S.C. § 112**

Claims 1-25 have been rejected under 35 U.S.C. § 112 on the grounds that the phrase “optionally positionable” is indefinite and may not make it clear that the applicant is claiming this element. The phrase in question was not chosen to indicate that the element was optional, but only that the **position** of the element could be selected by the installer such that the claimed element performed the relevant blocking function or not. The word “optionally” modified the word “positionable” and not the blocking element per se. As such, the word “optionally” was used to emphasize that the element could be positioned or not positioned as claimed.

In view of the fact that the word “positionable” inherently refers to the possibility of being positioned or not positioned, and that the claim specifically sets forth that the blocking element may function “to block or unblock,” it is clear that the emphasis provided by the word “optionally” is not required in any claim. The applicant agrees with the Examiner that clarity is improved by removing this emphasis. Consequently this word has been deleted throughout. It is believed that this amendment does not alter or affect the scope of the claims in any way.

**Rejections Under 35 U.S.C. § 102 (b)**

Claim 15 stands rejected under 35 U.S.C. § 102(b) in view of Hurd. Claims 15 and 16 stand rejected under 35 U.S.C. § 102(b) in view of Lyons, Fayngersh and or Tell, et al. Claim 15 has been amended to more clearly define the applicant’s invention. As discussed above, the term “optionally” has been deleted. The spindle

hub blocking element has been further defined to indicate that it is “positionable on the first sidewall to extend through the first sidewall into a moving path of the at least one spindle hub and into direct blocking contact with the at least one spindle hub to prevent rotation thereof.”

Hurd uses a “dogging lever 17,” having a “nose 16” that engages a “notch 15” in the “roll-back.” The term “roll-back” as used by Hurd appears to refer to the same element identified as the “spindle hub” in the applicant’s design. Hurd’s roll-back has the same opening for receiving a square cross-section spindle as found in the applicant’s design. Hurd’s roll-back is also directly turned by the handle in the same way as in the applicant’s design.

Similarly, Hurd’s “dogging lever” corresponds most closely to the “interfering member” of the applicant’s invention. The “dogging lever” of Hurd and the “interfering member 44” of the present invention are movable elements used during normal lock operation that provide the conventional function needed by a mortise lock of locking the outer handle by preventing the roll-back or spindle hub from rotating. This function is distinct from the function of the applicant’s “spindle hub blocking element” which is to semi-permanently disable the rotation of the outer handle.

To clarify this difference between the present invention and the cited references, claim 15 has been amended to introduce the interfering member. Hurd fails to disclose the combination of the conventional apparatus for preventing the rotation of the spindle hub/roll-back (hub rotation blocked only when the door is locked) with the spindle hub blocking element of the present invention (hub rotation blocked permanently unless the

mechanism is removed from the door and the blocking element removed from the now-accessible sidewall of the lock).

Moreover, Hurd's dogging lever is not "positionable on the first sidewall to extend through the first sidewall into a moving path of the at least one spindle hub and into direct blocking contact with the at least one spindle hub to prevent rotation thereof" as amended claim 15 now defines.

The comments above also apply to the disclosure in Lyons. The Lyons design simply blocks the rotation of the spindle "hub E" with "rotary stop G." The rotary stop G performs the conventional locking function performed by the interfering member of the present invention or the dogging lever of Hurd. Neither reference discloses or suggests the spindle hub blocking element of the present invention that is "positionable on the first sidewall to extend through the first sidewall into a moving path of the at least one spindle hub and into direct blocking contact with the at least one spindle hub to prevent rotation thereof" as found in amended claim 15.

Claims 15 and 16 have also been rejected under 35 U.S.C. § 102(b) in view of Fayngersh. The Examiner indicates that Fayngersh discloses the spindle hub blocking element of the present invention in the form of screw 154 (see Fig. 20 and column 9 lines 10 to 54 of Fayngersh). As is clear from that portion of the Fayngersh specification, the screw 154 is mounted in a threaded hole<sup>152</sup> which is formed in the moving "slide plate 142" of Fayngersh. More specifically, the "blocking screw 154" extends across the "slot 146" in the "tab 148" which forms the end of the "slide plate 142."

As in the preferred embodiment of the present invention Fayngersh has two spindle hubs. The "slide plate 142" has two slots ("slot 146") at its end, and a portion of each spindle hub passes through the corresponding slot. The "slide plate 142" of Fayngersh is connected to toggle 52 on the front of the lock. Thus, in the design of Fayngersh, by throwing the toggle 52, the "blocking screw 154" can move into or out of blocking relationship with the spindle hub. The screw can be moved from one side to the other to reverse the lock so that the inside becomes the outside, etc.

From the discussion above, it can be seen that the blocking screw of Fayngersh is not "positionable on the first sidewall" as specified in claim 15. It is positionable on the moving "slide plate 142" of Fayngersh so that it can be moved into and out of blocking contact with the spindle hub. The slide plate 142 of Fayngersh corresponds to the "rotary stop G" of Lyons, the "dogging lever" of Hurd, and the "interfering member 44" of the present invention, all of which are movable elements used during normal lock operation to provide a conventional lock function of locking the outer handle. None of these references disclose or suggest the combination of a blocking screw mounted on the sidewall with a movable interfering member to perform this conventional function.

The Examiner has further rejected claims 15 and 16 in view of Tell et al. As in the present invention, Tell's design is intended to semi-permanently prevent rotation of one of the handles by preventing the rotation of the associated spindle hub using a blocking element installed on the outside of the case. The blocking element becomes inaccessible when the lock is installed.

However, Tell's design of this feature (semi-permanent blocking of one of the spindle hubs) differs significantly from the present invention as now defined in amended claims 15 and 16. These claimed differences provide the present invention with several significant advantages over Tell's design. More specifically, in Tell's design, the rotation of the spindle hub (referred to as the "retractor 36" by Tell) is prevented by Tell's "lock lever 34" and not as in claim 15 by "a spindle hub blocking element positionable on the first sidewall to extend through the first sidewall into a moving path of the at least one spindle hub and into direct blocking contact with the at least one spindle hub to prevent rotation thereof."

The lock lever 34 of Tell is biased away from the spindle hub (retractor 36) by a spring 38. Thus, as described at column 4 line 12 of Tell et al., in order to install the spindle hub blocking element ("screw 40" in Tell's Fig. 1) Tell requires that "a rod type tool" be located and then inserted "through slot 102 on the selected side of the case assembly." The rod type tool must then be manipulated through slot 102 to move "that side's lock lever 34 toward retractor 36." Because the lock lever 34 is pushed away from the retractor 36 by spring 38, the installer must use the "rod type tool" to hold the lock lever through the hole 102 against the spring compression, while he simultaneously attempts to insert screw 40 into threaded hole 104 "to hold lock lever 34 in that position against the force of lock spring 38."

Tell's design and the steps above are significantly more difficult than the present design, which, as claimed, has a blocking element that extends through the first sidewall into the path of motion of the spindle hub to make direct blocking contact

therewith. Tell's blocking element is 1) not in the path of motion of the spindle hub and 2) does not directly contact the spindle hub.

In the present invention, this claimed design means that it is not necessary to use a special tool to hold a spring loaded piece against spring pressure as the blocking element is installed. The blocking element in the present invention can be installed into the path of the spindle hub when the handle is not turned. In Tell's design, if an attempt is made to install the screw 40 without using the special tool and spring compression procedure, the hub will not be blocked, or the lock lever 34 will be broken as the screw comes into contact with it.

In view of the comments and amendments above, it is respectfully requested that the rejections of claims 15 and 16 under 35 USC § 102(b) be withdrawn.

**Rejections Under 35 U.S.C. § 103(a) in view of Hurd**

Claims 1-25 have been rejected under 35 U.S.C. § 103(a) in view of Hurd. Regarding claim 1, the applicant has deleted the word "optionally" which resulted in the limitation of the "latch retract blocking element" not being considered. Although it is not believed that this amendment changes the scope of claim 1, it is believed that this amendment clarifies that the latch retract blocking element should be considered by the Examiner.

With respect to the Examiner's consideration of this element, Hurd does not disclose or suggest the claimed "latch retract blocking element" that operates to block the motion of the "latch retract lever." The Examiner has identified element 9 in Hurd as the latch retract lever. However, Hurd does not disclose anything that functions to

block that lever “to prevent the control hub from retracting the latch bolt, the latch retract blocking element being positionable without removing the first or second sidewall from the mortise lock to block or unblock the latch retract lever.” In Hurd’s design, latch retraction can only be prevented by blocking the rotation of the spindle hub (“rollback11”).

In addition to the point discussed above, claim 1 specifies “a control hub operably connected to the latch retract lever to move the latch bolt between the extended and retracted positions.” Claim 1 further states that the “latch retract lever [moves] the latch bolt between the extended and retracted positions.”

The Examiner has corresponded element 22 of Hurd to the “control hub” of the present invention and element 9 of Hurd to the claimed “latch retract lever.” However, element 22 of Hurd does not function to move element 9 to move “the latch bolt between the extended and retracted positions.” This can clearly be seen in Figs 1 and 2 of Hurd which show element 22 in both orientations it can achieve. In both orientations, the “latch bolt” 4 is extended. Thus, Hurd fails to disclose this claimed aspect of the present invention.

Regarding claim 2, a similar amendment has been made to remove the word “optionally.” This amendment clarifies that this language is directed to a positive limitation comprising a “lock/unlock blocking element” that is not found in Hurd. Specifically, Hurd fails to show an element which “block[s] the lock/unlock lever to prevent the control hub from moving the lock/unlock lever between the locked and unlocked positions,” and which is “positionable without removing the first or second sidewall from the mortise lock.”



As to claims 4 and 5, again, the word “optionally” has been deleted. Thus, these claims require three separate “blocking elements,” one for the spindle hub (introduced in claim 4), one for the lock/unlock lever (introduced in claim 2 from which claim 4 depends) and one for the latch retract lever (introduced in claim 1 from which claims 2 and 4 depend). None of these elements are found in Hurd.

With respect to claim 10, the word “optionally” has been deleted from the claim language defining the position of the lock/unlock blocking element. The Examiner is requested to consider this element and to note that Hurd does not disclose the claimed “lock/unlock blocking element” that is “positionable without removing the first or second sidewall from the mortise lock to block or unblock the lock/unlock lever.” Hurd’s design lacks any element that functions in the claimed way to prevent the lock/unlock lever from moving.

With respect to claim 20 and Hurd, the word “optionally” has been deleted from the claim language defining the position of the “lock/unlock blocking element” and the position of the “spindle hub blocking element.” The comments above in connection with claims 2 and 10 concerning this element and the lack of disclosure in Hurd apply equally to claim 20.

Moreover, the comments above with respect to claim 1 also apply to claim 20. Hurd does not disclose anything that functions to block the latch retract lever. In Hurd’s design, latch retraction can only be prevented by blocking the rotation of the spindle hub (“rollback11”), not the latch retract lever.

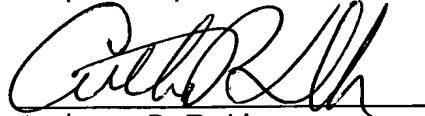
In addition, as in claim 1, claim 20 specifies “a control hub operably connected to the latch retract lever.” Claim 20 and claim 1 further state that the “latch retract lever

[moves] the latch bolt between the extended and retracted positions." The element 22, which the Examiner has corresponded to the "control hub" of the present invention does not function to move element 9 (the latch retract lever) so as to move "the latch bolt between the extended and retracted positions." This can clearly be seen in Figs 1 and 2 of Hurd which show element 22 in both orientations.

As to the remaining claims, the rejections of which all omitted consideration of the various "blocking elements" that are installed from outside the case, it is believed that the discussions above and the amendments to delete the term "optionally" establish that these claims are allowable.

In view of the amendments made above, it is respectfully submitted that the application has now been brought into a condition where allowance of the entire case is proper. Reconsideration and issuance of a notice of allowance are respectfully solicited.

Respectfully submitted,




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